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10/669,345	09/25/2003	Valerie Walker	1456-3/MBE	6610
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DIMOCK STRATTON LLP 20 QUEEN STREET WEST SUITE 3202, BOX 102 TORONTO, ON M5H 3R3 CANADA			EXAMINER HEALD, ROBYN SUE	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/669,345

Applicant(s)

WALKER ET AL.

Examiner

Robyn S. Heald

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7 and 11-16, drawn to a method of adhering, classified in class 156, subclass 291.
  - II. Claims 8-10 and 17-19, drawn to a product made by method of adhering, classified in class 428, subclass 198.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed could be made by a method where the anchoring adhesive is cured after the bonding adhesive has been applied.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mark B. Eisen on December 1, 2005, a provisional election was made without traverse to prosecute the Invention I, claims 1-7 and 11-16. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 8-10 and 17-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

6. Claim 6 is objected to because of the following informalities: claim 6 is claiming dependency from claim 6. This is understood to be a typographical error, and the dependency is assumed to be from claim 1 and examined accordingly. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5-7, 11, 13, 15, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. (U.S. Patent 5,589,246) in view of Komura et al. (U.S. Patent 4,440,821).

With respect to claim 1, Calhoun et al. discloses a method of adhering a first material (the substrate, column 2, line 3) to a second material 311, comprising: applying an anchoring adhesive 318 to the second material 311, to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces; after the anchoring adhesive 318 has cured, applying a bonding adhesive 316 to the second material 311; and adhering the first and second materials together, whereby the bonding adhesive 316 intrudes into the interstitial spaces and bonds to the adhesive anchors 318 (figure 5, column 3, lines 31-45, column 7, line 55, thru column 8, line 6).

Calhoun et al. is silent to the positioning of the first material while adhesives 318 and 316 are applied to second material 311, but it would have been obvious to the skilled artisan that the first material would be positioned on a work surface, depending on the particular substrate used, with an adhesion zone exposed to await the joining of the two materials. Calhoun et al. is also silent to the degrees of adhesion between the anchoring adhesive 318 and the bonding adhesive 316.

One skilled in the art would appreciate when using two different adhesives the adhesives would most likely have different adhesive strengths. Regardless, it would have been obvious to use an adhesive 318 that adheres more strongly to material 311 than the adhesive 316 to prevent delamination; especially since the concept of adhering two materials with an adhesive 2 having a higher degree of adhesion than an adhesive 3, so that in cases of peeling of the adhesive 3 the two materials would still be bonded together by adhesive 2, is commonly known, as taught by Komura et al. (figures 1 and 4, column 3, lines 15-21, and column 4, lines 30-37).

Regarding claim 3, the adhesive anchors 318 are applied in a uniform pattern (figures 5).

Regarding claim 5, it would have been within perview of the skilled artisan to make the bonding adhesive 316 flexible, because a flexible bonding adhesive would enable the removal of the adhesive article (column 10, lines 34-39).

Regaring claim 6, it would have been within perview of the skilled artisan to make the anchoring adhesive 108 rigid, because a rigid anchor adhesive would better allow for the positioning and repositioning of the adhesive article (column 6, lines 3-7).

Regaring claim 7, the anchoring adhesive 318 is applied to the second material 311, and it can be assumed that the second material 311 would be positioned on a work surface with an adhesion zone exposed for the application of anchoring adhesive 311 (figure 5).

With respect to claim 11, Calhoun et al. discloses a method of adhering a casting adhesive 316 to a material 311, comprising: positioning the material 311 on a work surface, with an adhesion zone exposed; applying an anchoring adhesive 318 to the material 311, to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces; after the anchoring adhesive 318 has cured, applying a casting adhesive 316 to the material 311, whereby the casting adhesive 316 intrudes into the interstitial spaces and bonds to the adhesive anchors 318 (figure 5, column 3, lines 31-45, column 7, line 55, thru column 8, line 6). Calhoun et al. is silent to the degrees of adhesion between the anchoring adhesive 318 and the bonding adhesive 316.

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One skilled in the art would appreciate when using two different adhesives the adhesives would most likely have different adhesive strengths. Regardless, it would have been obvious to use an adhesive 318 that adheres more strongly to material 311 than the adhesive 316 to prevent delamination; especially since the concept of adhering two materials with an adhesive 2 having a higher degree of adhesion than an adhesive 3, so that in cases of peeling of the adhesive 3 the two materials would still be bonded together by adhesive 2, is commonly known, as taught by Komura et al. (figures 1 and 4, column 3, lines 15-21, and column 4, lines 30-37).

Regarding claim 13, the adhesive anchors 318 are applied in a uniform pattern (figures 5).

Regarding claim 15, it would have been within perview of the skilled artisan to make the bonding adhesive 316 flexible, because a flexible bonding adhesive would enable the removal of the adhesive article (column 10, lines 34-39).

Regarding claim 16, it would have been within perview of the skilled artisan to make the anchoring adhesive 108 rigid, because a rigid anchor adhesive would better allow for the positioning and repositioning of the adhesive article (column 6, lines 3-7).

9. Claims 2, 4, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calhoun et al. and Komura et al. as applied to claims 1 and 11 above, and further in view of Simila (U.S. Patent Application Publication 2003/0183332) and Ono et al. (U.S. Patent 6,909,180).

Regarding claim 2, Calhoun et al. discloses the conventional coating techniques may be used to apply the adhesives to the second material 311 (column 11, lines 3-8),

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but is not specific to using a screen. The use of a screen to apply adhesive at intermittent locations on a material is commonly known in the art. Simila discloses a method of applying an anchoring adhesive 108 at intermittent locations on a material 102 by using a screen (figures 10-12, page 1, paragraph 0010, and page 2, paragraph 0024). Ono et al. also discloses a method of applying an anchoring adhesive 3 at intermittent locations on a material 1 by using a screen (figure 3A, column 57-65, and column 9, lines 2-10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use a screen, like that used by Simila and Ono et al., for the application of the anchoring adhesive 318 to the second material 311, because using such a technique will better acquire the raised surface desired for the adhesive article.

Regarding claim 4, the screens used by Simila (figures 10-12, page 3, paragraph 0030) and Ono et al. (figures 2, 3A, and 9, and column 9, lines 2-10) provide a grid with adhesive-impervious portions.

Regarding claim 12, Calhoun et al. discloses the conventional coating techniques may be used to apply the adhesives to the material 311 (column 11, lines 3-8), but is not specific to using a screen. The use of a screen to apply adhesive at intermittent locations on a material is commonly known in the art. Simila discloses a method of applying an anchoring adhesive 108 at intermittent locations on a material 102 by using a screen (figures 10-12, page 1, paragraph 0010, and page 2, paragraph 0024). Ono et al. also discloses a method of applying an anchoring adhesive 3 at intermittent locations on a material 1 by using a screen (figure 3A, column 57-65, and column 9, lines 2-10).



Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to use a screen, like that used by Simila and Ono et al., for the application of the anchoring adhesive 318 to the material 311, because using such a technique will better acquire the raised surface desired for the adhesive article.

Regarding claim 14, the screens used by Simila (figures 10-12, page 3, paragraph 0030) and Ono et al. (figures 2, 3A, and 9, and column 9, lines 2-10) provide a grid with adhesive-impervious portions.

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simila in view of Komura et al.

With respect to claim 1, Simila discloses a method of adhering a first material 104 to a second material 102, comprising: applying an anchoring adhesive 108 to the second material 108, to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces; after the anchoring adhesive 108 has cured, applying a bonding adhesive 124 to the second material 102; and adhering the first and second materials 104 and 102 together, whereby the bonding adhesive 124 intrudes into the interstitial spaces and bonds to the adhesive anchors 108 (figures 10-12, page 1, paragraph 0010, and page 2, paragraph 0024).

Simila is silent to the positioning of the first material 104 while adhesives 108 and 124 are applied to second material 102, but it would have been obvious to the skilled artisan that the first material 104 would be positioned on a work surface with an adhesion zone exposed to await the joining of the two materials 104 and 102. Simila is

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also silent to the degrees of adhesion between the anchoring adhesive 108 and the bonding adhesive 124.

One skilled in the art would appreciate when using two different adhesives the adhesives would most likely have different adhesive strengths. Regardless, it would have been obvious to use an adhesive 318 that adheres more strongly to material 311 than the adhesive 316 to prevent delamination; especially since the concept of adhering two materials with an adhesive 2 having a higher degree of adhesion than an adhesive 3, so that in cases of peeling of the adhesive 3 the two materials would still be bonded together by adhesive 2, is commonly known, as taught by Komura et al. (figures 1 and 4, column 3, lines 15-21, and column 4, lines 30-37).

Regarding claim 2, the step of applying anchoring adhesive 108 comprises positioning a screen in contact with at least the adhesion zone, applying the anchoring adhesive 108 through the screen, and removing the screen (page 3, paragraphs 0030 and 0038, and page 7, paragraph 0080).

Regarding claim 3, the adhesive anchors 108 are applied in a uniform pattern (figures 10-12, page 3, paragraph 0030).

Regarding claim 4, the screen provides a grid of adhesive-impervious portions (figures 10-12, page 3, paragraph 0030).

Regarding claim 5, the bonding adhesive 124 may be flexible (page 6, paragraph 0078).

Regarding claim 6, the anchoring adhesive 108 may be rigid (page 4, paragraph 0045).

Regarding claim 7, the anchoring adhesive 108 is applied to the second material 102, and it can be assumed that the second material 102 would be positioned on a work surface with an adhesion zone exposed for the application of anchoring adhesive 108 (figures 10-12).

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al. in view of Komura et al.

With respect to claim 1, Ono et al. discloses a method of adhering a first material 50 to a second material 1, comprising: applying an anchoring adhesive 3 to the second material 1, to form a plurality of substantially isolated adhesive anchors separated by interstitial spaces; after the anchoring adhesive 3 has cured, applying a bonding adhesive 4 or 43 to the second material 1; and adhering the first and second materials 50 and 1 together, whereby the bonding adhesive 4 or 43 intrudes into the interstitial spaces and bonds to the adhesive anchors 3 (figures 2 and 9, column 6, lines 5-15).

Ono et al. is silent to the positioning of the first material 50 while adhesives 3 and 4 or 43 are applied to second material 1, but it would have been obvious to the skilled artisan that the first material 50 would be positioned on a work surface, for applying components 6, 7, and 70, with an adhesion zone exposed to await the joining of the two materials 50 and 1. Ono et al. is also silent to the degrees of adhesion between the anchoring adhesive 3 and the bonding adhesive 4 or 43.

One skilled in the art would appreciate when using two different adhesives the adhesives would most likely have different adhesive strengths. Regardless, it would have been obvious to use an adhesive 318 that adheres more strongly to material 311

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than the adhesive 316 to prevent delamination; especially since the concept of adhering two materials with an adhesive 2 having a higher degree of adhesion than an adhesive 3, so that in cases of peeling of the adhesive 3 the two materials would still be bonded together by adhesive 2, is commonly known, as taught by Komura et al. (figures 1 and 4, column 3, lines 15-21, and column 4, lines 30-37).

Regarding claim 2, the step of applying anchoring adhesive 3 comprises positioning a screen 8 in contact with at least the adhesion zone, applying the anchoring adhesive 3 through the screen 8, and removing the screen 8 (figure 3A, column 57-65, and column 9, lines 2-10).

Regarding claim 3, the adhesive anchors 3 are applied in a uniform pattern (figures 2, 3A, and 9, and column 9, lines 2-10).

Regarding claim 4, the screen provides a grid of adhesive-impervious portions (figures 2, 3A, and 9, and column 9, lines 2-10).

Regarding claim 5, the bonding adhesive 43 may be flexible (column 12, lines 58-67, and column 13, lines 20-29).

Regarding claim 7, the anchoring adhesive 3 is applied to the second material 1, and it can be assumed that the second material 1 would be positioned on a work surface with an adhesion zone exposed for the application of anchoring adhesive 3 (figures 2, 3A, and 9).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Robyn S. Heald** whose telephone number is **571-272-**

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**2362.** The examiner can normally be reached on Mon-Thur, 8:00-5:30; every second Fri, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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